REMARKS

In the Office Action, the Examiner rejected claims 1-28. Applicant amends claims 1, 5, and 17 to correct minor clerical errors in these claims. However, for at least the reasons set forth below, Applicant respectfully submits that all of pending claims 1-28 are presently allowable. Accordingly, Applicant respectfully requests reconsideration of the above-referenced application in view of the foregoing amendments and the following remarks.

Claim Objection

In the Office Action, the Examiner objected to claim 5, noting that "[i]t is unclear how the historical event data is related to each component." Office Action mailed December 20, 2006, page 2. Applicant thanks the Examiner for pointing out this clerical error, and has amended claim 5 (as well as claim 17) to correct this error. In view of these amendments, Applicant respectfully request withdrawal of the instant objection to claim 5.

Rejections under 35 U.S.C. § 103

In the Office Action, the Examiner rejected claims 1-7 under 35 U.S.C. § 103(a) as unpatentable over Tkacs et al. (U.S. Patent No. 5,526,268) in view of Bapat (U.S. Patent No. 4,916,610) and prior art allegedly admitted by Applicant (particularly, pages 1 and 2 of the specification of the instant application). Claim 8 is also rejected under 35 U.S.C. § 103(a) as unpatentable over Tkacs et al., Bapat, and Applicant's specification, in view of Bargh et al. (U.S. Patent No. 6,212,491). Further, the Examiner rejected claims 9-20 and 22-28 under 35 U.S.C. § 103(a) as unpatentable over Tkacs et al. in view of Applicant's specification, and rejected claim 21 under 35 U.S.C. § 103(a) as unpatentable over Tkacs et al. and Applicant's specification, in view of Bargh. Applicant respectfully traverses these rejections.

Legal Precedent

The burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). When prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988).

Further, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.*

Omitted Features of Independent Claims 1, 9, and 20

Applicant respectfully notes that the Tkacs et al. and Bapat references, as well as the background section of Applicant's specification, collectively fail to disclose each element of independent claims 1, 9, and 20. For instance, independent claim 1 recites "a plurality of monitoring screens...including representations based upon monitoring data collected...via the data network *from the components in which identifying component data is stored*" (emphasis added). Further, independent claim 9 recites "a plurality of components...including at least *data* identifying the components *stored in the respective components*" (emphasis added). Also, independent claim 20 recites "accessing component status and identity data *from a plurality of electrical components*" (emphasis added). Because the cited references fail to disclose such elements, the cited references cannot support a *prima facie* case of obviousness with respect to independent claims 1, 9, and 20.

In the Office Action, the Examiner acknowledged that the Tkacs et al. reference fails to provide any teaching analogous to the storing and/or collecting of identifying component data stored within the components themselves, as variously recited by the independent claims. *See* Office Action mailed December 20, 2006, page 4; *see also id.* at pages 6-8. In an attempt to overcome this deficiency, the Examiner now alleges that such elements are inherently disclosed by statements contained in the specification of Applicant's present application. The Examiner's reliance on these statements is, at best, misplaced.

Referring to Applicant's specification, the passage that the Examiner believes to be relevant reads:

> A wide variety of systems are available for control and monitoring functions, particularly in industrial settings. Such systems may include components which regulate the application of electrical power to loads, such [as] electric

> motors. In a motor control center, for example, circuit protection devices, component protection devices, drives, starters, relays, disconnects, and so forth are interconnected to carryout desired industrial processes. The processes may be defined by pre-established routines, and may rely upon sensed parameters and operator-induced command inputs, all of which are transmitted through a data network.

Specification, page 1, lines 12-19. Particularly, the Examiner emphasizes that this passage refers to "components which regulate the application of electrical power to load." *See, e.g.*, Office Action mailed December 20, 2007, page 6. Applicant respectfully notes that the immediately following sentence provides numerous examples of such components for regulating electrical power, including relays, starters, disconnects, and the like. The Examiner also emphasizes that the paragraph reproduced above also states that industrial processes "may rely upon sensed parameters." *Id.* From these passages, the Examiner has somehow concluded that "[s]ince the parameters are sensed from the components, the components inherently store data and transmit the data through the network." *Id.* This conclusion of inherent disclosure does not logically flow from the passages cited by the Examiner and is, in fact, untenable.

Applicant respectfully points out that the Examiner's conclusion (that the components inherently store data and transmit the data through the network) is based on an incorrect and false assumption as to the allegedly relevant passage of Applicant's specification (that this passage somehow discloses that the parameters are sensed from the components). First, it is noted that the passage relied on by the Examiner merely states that industrial processes (such as motor starting and/or shut-down) may rely upon sensed parameters. Specification, page 1, lines 14-19. The passage does not, in fact, teach or suggest that the sensed parameters are sensed from the control components, as asserted by the Examiner. Indeed, in numerous applications, such parameters are be sensed *by*, rather than *from*, the control components.

As will be appreciated by one skilled in the art, many components (such as relays, disconnects, and the like) are configured to "sense" (i.e., detect) various physical phenomenon (such as the electric current flowing through a conductor, the temperature, and so forth) and react if the sensed phenomenon is outside a certain desired range. For instance, in one exemplary system, a relay may be mechanically configured to sense the current passing to a motor from a power source through a conductor, and to disconnect the motor from the power source if the current exceeds a certain threshold. In another system, a disconnect may include a mechanical, temperature-responsive, switch (which may employ a bi-metal strip, for instance) that opens a power distribution circuit when the sensed temperature exceeds a certain level. In each of these two exemplary systems, the component is mechanically configured to produce a result (i.e., open the circuit) in response to a sensed physical phenomenon or parameter. In other embodiments, control signals (on, off, reset, or the like) may be distributed to such components in response to sensed operating parameters, or in response to operator commands. In short, although these control components may sense operating parameters, there is nothing in the passage of Applicant's specification relied upon by the Examiner that discloses, either explicitly or inherently, that these operating parameters are sensed from the control components.

Moreover, while components such as relays, disconnects, and the like may *sense* physical phenomenon and parameters of the system, it is evident that such components do not necessarily *store* such parameters. Returning to the exemplary control components noted above, and as would be appreciated by one skilled in the art, the relay and the disconnect may each sense operating parameters (current and temperature, respectively, in the examples above) and contain elements that physically move in response to such parameters (via electromagnetic force, thermal expansion, or the like) to disrupt power flow to the motor. It is clear that such control components, and other similar components, while acting in response to a sensed parameter, do not necessarily *store* the sensed parameters, let alone transmit the sensed parameters to other devices.

Ultimately, the passage of Applicant's specification on which the Examiner relies merely teaches that control components may be used to carryout industrial processes, and that such industrial processes may rely, in part, on sensed parameters. There is not any teaching in this brief background passage that such parameters are *necessarily* sensed from a control component, that sensed parameters are *necessarily* stored in a control component, or that such control components *necessarily* store component identifying information along with a sensed parameter. *See In re Robertson*, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999). Consequently, this background passage fails to disclose, inherently or otherwise, "a plurality of components...including at least data identifying the components stored in the respective components," or collecting component identification data from such components, as generally recited by the present claims. As none of the prior art of record obviates this deficiency, the present rejection fails to establish a *prima facie* case of obviousness with respect to independent claims 1, 9, and 20, or with respect to their dependent claims.

Deficiencies of the Rejection of Dependent Claims 8 and 21

Applicant respectfully notes that claims 8 and 21 depend from independent claims 1 and 20, respectively. As discussed above, the Tkacs et al. reference fails to disclose each element of independent claims 1 and 20. Further, Appellant respectfully submits that the Bapat and Bargh et al. references do not obviate the deficiencies of the Tkacs et al. reference discussed above with respect to the independent claims. As a result, Applicant respectfully asserts that dependent claims 8 and 21 are allowable on the basis of their dependency from a respective allowable independent claim, as well as for the subject matter separately recited in these dependent claims.

For at least these reasons, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 103 and allowance of claims 1-28.

Conclusion

In view of the remarks and amendments set forth above, Applicant respectfully requests allowance of the pending claims. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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